

17. (Amended Three Times) A method for capturing information from a substrate using an apparatus having a viewing area for assisting a user in positioning the apparatus over a particular area of the substrate, comprising:
positioning an apparatus over a particular area of a substrate using the viewing area; and
capturing coded embedded data from the surface of the substrate, said embedded data including an orientation of the substrate and a location of the coded embedded data on the substrate.

REMARKS

This is in reply to the Examiner's Official Action dated November 19, 2002. Claims 1-32 are currently pending in the present application. Reconsideration of this application in light of these remarks, and allowance of this application are respectfully requested.

I. Claim Objections

Claims 1 and 7 are objected to because of minor informalities. The informalities have been corrected. It is therefore asserted that the claims no longer contain minor informalities. Applicant respectfully requests that the Examiner withdraw her objections to claims 1 and 7.

II. Rejection Of Claims Under 35 U.S.C. § 103(a)

Claims 1-3, 9-12, 16-19, 25-28 and 32 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,945,661 to Nukui et al. (hereinafter, Nukui) in view of U.S.

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Patent No. 5,304,787 to Wang (hereinafter referred to as Wang '787). Reconsideration of the rejection is respectfully requested.

According to the Examiner, Nukui teaches:

a data symbol reading device for reading a data symbol featuring data embedded therein, having an indication section which notifies the device user of a positioning condition of the device relative to a symbol reading area of the data symbol on a surface. The device also features an operation switch, two light sources, and a charge coupled device.

(November 19, 2002 Official Action at page 3.) (Nukui references removed.) The Examiner admits that Nukui fails to specifically teach embedded data including orientation of the substrate and a location of the coded embedded data on the substrate, and she cites Wang '787 for teaching:

a stored image area which encases a two-dimensional bar code. Stored image data representing the image area is sampled along or between parallel scan lines. The image data is then analyzed to determine the bounds and orientation of the bar code (col. 5, line 38 - col. 6, line 6).

(Id. at page 4) The Examiner further alleges that:

[o]ne of ordinary skill in the art would have readily recognized that it would have been beneficial to the invention of Nukui to determine the position and orientation of the code for use in enabling the further processing of the image. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Nukui with the aforementioned teaching of Wang '787.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001).) Second, a reasonable expectation of success must exist. Third, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

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available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Moreover, each of these requirements must "be found in the prior art, and not based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001).) In this case, the Examiner does not argue, and the references do not teach all the claim limitations. More specifically, neither reference teaches, suggests or discloses the capability to capture coded embedded data from the surface of the substrate, said embedded data including a location of the coded embedded data on the substrate. Therefore, the rejection of independent claims 1 and 17 under 35 U.S.C. § 103(a) as unpatentable over Nukui in view of Wang '787 should be withdrawn. The rejection of dependent claims 2-3, 9-12, 16, 18-19, 25-28 and 32 should also be withdrawn as they depend on allowable subject matter as recited in the respective independent claims from which they directly or indirectly depend.

Even if the above-noted deficiency did not exist, it is respectfully asserted that Wang '787 is further lacking because it fails to teach, suggest or disclose the capability to capture coded embedded data from the surface of the substrate, said embedded data including an orientation of the substrate. A careful reading of Wang '787 reveals that instead of providing an orientation of the substrate, the image data provides the orientation of the bar code. (See e.g., col. 6, lines 1-4; lines 13-14; and lines 23-24.) Nowhere does Wang '787 indicate that the orientation of the bar code is equivalent to the orientation of the substrate. In fact, Wang '787 specifically teaches away from a bar code orientation that is equivalent to the orientation of the substrate when it provides that "the bar code image will typically have a skewed alignment within the scanned image area and the bar code image may actually appear on end or upside

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down within the scanned image area.” (col. 3, lines 50-53.) Therefore, it is respectfully asserted that Wang ‘787 also fails to teach this feature.

The Examiner also rejects claims 4-8, 13-15, 20-24 and 29-31 under 35 U.S.C. § 103(a) as unpatentable over Nukui in view of Wang ‘787 as applied to claim 1, and further in view of U.S. Patent No. 5,513,264 to Wang (hereinafter, Wang ‘264). According to the Examiner, Nukui/Wang ‘787 “lack the teaching of a viewing area comprising a display for displaying an image based on the coded embedded data” and she cites Wang ‘264 for allegedly teaching this feature. For the same reasons articulated above, Applicants respectfully submit that the withdrawal of the rejection of claims 4-8, 13-15, 20-24 and 29-31 under 35 U.S.C. § 103(a) is in order as they depend from allowable base claims.

III. Conclusion

In view of the foregoing, it is submitted that the cited prior art considered separately or in combination fails to teach or suggest the Applicants’ invention. Therefore, it is respectfully asserted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, she is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

If any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this response, and not requested by attachment, such extension is hereby requested. If there are any fees due under 37 C.F.R. § 1.16 or 1.17 that are not enclosed, including any fees required for an

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extension of time under 37 C.F.R. § 1.136, please charge those fees to Xerox Deposit Account
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Respectfully submitted,

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